

REMARKS

Claims 1 to 5, 7 to 13, and 15 to 17 are now pending.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With respect to paragraph four (4), claims 1 to 3, 7, 9 to 11, 15 and 17 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,207,580 ("Strecher") in view of "Joao", U.S. Published Patent Application No. 2001/0032099.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. See *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

The Final Office Action cited Joao for the claim feature of "storing scenarios each of which is standardized". In fact, Paragraph 0049 of Joao states: "Data and/or information collected and/or stored by the apparatus, which relates to symptoms and/or conditions, as well as responses to treatments, can be utilized in order to present realistic and confidential training scenarios". Still further, Paragraph 310 states: "In this manner, the present invention can utilize information obtained from other preferred embodiments in order to provide simulated training scenarios". Still further, claim 17 of Jao recites "receiving information regarding at least one of a healthcare diagnosis and a prescribed healthcare

treatment in response to a presented healthcare scenario”, that the “processor applies said information regarding at least one of a healthcare diagnosis and a prescribed healthcare to said presented healthcare scenario”, that the “processor generates a revised healthcare scenario”, and that the “processor stores said information regarding said revised healthcare scenario”.

Accordingly, it is plain that Jao does not disclose nor suggest, whether taken alone or combined with the primary reference, the feature of storing scenarios each of which is standardized that are used for preparing a health promotion schedule, as provided for in the context of each of the independent claims. At best, Joao may refer to providing and storing training scenarios by using information regarding a healthcare diagnosis and the like.

Still further, as previously explained, claims 1, 9 and 17, include the features of: storing scenarios each of which is standardized and includes a target lifestyle, a level of readiness for change, standardized health promotion timing, and standardized health promotion information corresponding to said level of readiness for change and corresponding to said standardized health promotion timing; obtaining data on lifestyles and said level of readiness for change of a client; generating health promotion information and health promotion timing, from a stored scenario, corresponding to said lifestyle and said level of readiness for change of said client to prepare a health promotion schedule of said client that includes said health promotion information and health promotion scheduled date based on said health promotion timing; storing said health promotion schedule; unfolding a schedule by reading a stored health promotion schedule and generating a calendar indicating said health promotion scheduled date and display said calendar on a display part of said health promotion practitioner support apparatus or on a terminal which can access said health promotion practitioner support apparatus; and outputting said health promotion information corresponding to said health promotion scheduled date selected by a health promotion practitioner on said calendar.

These claim features are supported by the present application, including the disclosures at page 15, line 24 to page 17, line 3, and page 17, lines 7 to 35, original claim 5 and Figures 20, 22, 23 and 24.

The prior reasons provided in the prior responses as to Strecher are maintained and incorporated herein.

Claim 1 provides for *generating health promotion information and health promotion timing, from a stored scenario, corresponding to said lifestyle and said level of readiness for change of said client to prepare a health promotion schedule of said client that includes said health promotion information and health promotion scheduled date based on said health promotion timing.*

The “Strecher” reference does not in any way disclose nor suggest these features. In this regard (even accepting the assertions of the Office Actions to date for purposes of this response), the “Strecher” reference apparently only refers to “obtaining” such data – *but the “Strecher” reference does not in any way disclose or even suggest the feature of generating health promotion information and health promotion timing, from a stored scenario, corresponding to said lifestyle and said level of readiness for change of said client to prepare a health promotion schedule of said client that includes said health promotion information and health promotion scheduled date based on said health promotion timing, as provided for in the context of the subject matter of claim 1, as presented.*

As to the secondary Joao reference – and as explained above, it does not cure – and is not asserted to cure – the critical deficiencies of the Strecher reference as to the “generating” feature discussed above, and as provided for in the context of the presently claimed subject matter.

A review of the text cited in the Final Office Action provides no proper support for the assertions of the Office Actions to date as to the presently claimed subject matter of claim 1.

As further regards the obviousness rejections, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify the reference does not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original). Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” — which is not the case here — there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). As referred to above, any review of the reference makes plain that the reference simply does not describe the features discussed above of the rejected claims.

It is therefore respectfully submitted that claim 1 is allowable for these reasons.

Claims 9 and 17 include features like those of claim 1 and are therefore allowable for essentially the same reasons as claim 1.

Claims 2 to 5, 7 and 8 depend from claim 1, and are therefore allowable at least for the same reasons as claim 1. Claims 10 to 13, 15 and 16 depend from claim 9, and are therefore allowable at least for the same reasons as claim 9.

It is therefore respectfully submitted that claims 1 to 5, 7 to 13, and 15 to 17 are allowable, and that the obviousness rejections of the claims should be withdrawn.

With respect to paragraph five (5), claims 4 and 12 were rejected under 35 U.S.C. § 103(a) as unpatentable over the “Strecher” reference in view of “Joao” and in further view of the Rieger article.

Claim 4 depends from allowable claim 1. It is therefore respectfully requested that the obviousness rejections be withdrawn since claim 4 is allowable for essentially the same reasons as claim 1, and since the “Rieger” reference does not cure – and is not asserted to cure -- the critical deficiencies of the “Strecher” and “Joao” references, which were explained above. This is because any review of the third-level “Rieger” reference makes clear that it simply does not in any way disclose or suggest the features of claim 1, as presented, and as explained above. Accordingly, claim 4 is allowable.

Claim 12 depends from allowable claim 9. It is therefore respectfully requested that the obviousness rejections be withdrawn since claim 12 is allowable for essentially the same reasons as claim 9, and since the “Rieger” reference does not cure – and is not asserted to cure -- the critical deficiencies of the “Strecher” and “Joao” references, which were explained above. This is because any review of the third-level “Rieger” reference makes clear that it simply does not in any way disclose or suggest the features of claim 1, as presented, and as explained above. Accordingly, claim 12 is allowable.

With respect to paragraph six (6), claims 5, 8, 13 and 16 were rejected under 35 U.S.C. § 103(a) as unpatentable over the “Strecher” reference in view “Joao”, and in further view of U.S. Patent No. 6,039,688 (“Douglass”).

Claims 5 and 8 depend from allowable claim 1, as explained above. It is therefore respectfully requested that the obviousness rejections be withdrawn since claim 5 and claim 8 are allowable for essentially the same reasons as claim 1, and since the “Douglass” reference does not cure the critical deficiencies of the “Strecher” and “Joao” references, which were explained above. This is because any review of the third-level “Douglass” reference makes clear that it simply does not in any way disclose or suggest the features of claim 1, as presented, as explained above. Accordingly, claims 5 and 8 are allowable.

Claims 13 and 16 depend from allowable claim 9. It is therefore respectfully requested that the obviousness rejections be withdrawn since claims 13 and 16 are allowable for essentially the same reasons as claim 9, and since the “Douglass” reference does not cure the critical deficiencies of the “Strecher” and “Joao” references, which were explained above. This is because any review of the third-level “Douglass” reference makes clear that it simply does not in any way disclose or suggest the features of claim 9, as explained above. Accordingly, claims 13 and 16 are allowable.

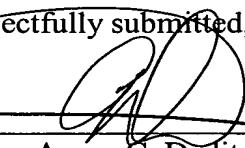
It is therefore respectfully submitted that claims 1 to 5, 7 to 13, and 15 to 17 are allowable.

Conclusion

It is therefore respectfully submitted that all of claims 1 to 5, 7 to 13, and 15 to 17 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Dated: 4/9/2008

Respectfully submitted,

By: 

Aaron C. Deditch
Reg. No. 33,865

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646

1507468